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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,588	12/09/2004	Alexander Fuchs	LU 6021 (US)	1330
34872	7590	06/05/2007		
BASELL USA INC. INTELLECTUAL PROPERTY 912 APPLETON ROAD ELKTON, MD 21921			EXAMINER NUTTER, NATHAN M	
			ART UNIT 1711	PAPER NUMBER
			MAIL DATE 06/05/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/517,588	<b>Applicant(s)</b> FUCHS ET AL.	
	<b>Examiner</b> Nathan M. Nutter	<b>Art Unit</b> 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 17-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>04-07</u> . | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

Applicant's election with traverse of Group I, claims 17-24, in the reply filed on 9 April 2007 is acknowledged. The traversal is on the ground(s) that the four groups of inventions do not lack a single inventive concept under PCT Rule 13.1. This is not found persuasive because 37 CFR 1.475 defines the unity to include one of the following situations:

**§ 1.475 Unity of invention before the International Searching Authority, the International Preliminary Examining Authority and during the national stage.**

- (a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.
- (b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:
  - (1) A product and a process specially adapted for the manufacture of said product; or
  - (2) A product and process of use of said product; or
  - (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
  - (4) A process and an apparatus or means specifically designed for carrying out the said process; or
  - (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

Claims 17-24 define a composition, claim 25 defines a method of making and claim 26 defines a "process" of using the composition. Applicants are not entitled to two products, i.e. a composition and "a fiber, film or molding."

Applicants' contention is erroneous. However, in the interest of prosecution brevity and in view of the prior art found and/or presented, the restriction is withdrawn.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation in claim 19 of "exclusively" is not clear as to its inclusion either for the copolymer "A)" or copolymer "B)."

Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the steps required to manufacture the product, whether it be an extrusion, mixing, etc..

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 1711

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 17-27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 and 9-15 of copending Application No. 10/517,580 (Fuchs et al US 2006/0167185), newly cited. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims embrace the polymers and their compositional limitations as herein recited and claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17-20, 22, 24, 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Hüffer et al (US 5,773,516), newly cited.

The reference to Hüffer et al teaches the manufacture of a propylene copolymer composition having a first copolymer, "containing from 0 to 15% by weight

Art Unit: 1711

copolymerized C<sub>2</sub>-C<sub>20</sub>-alk-1-enes" which embraces the recited range at 1 to 80% by weight, with a second propylene copolymer, "containing from 15 to 15% by weight copolymerized C<sub>2</sub>-C<sub>20</sub>-alk-1-enes" which embraces the recited range at 15 to 30% by weight, as recited in claim 17. Note the Abstract. The other monomer may be exclusively ethylene (claim 19). The range of inclusion of the first copolymer is taught to be "25 to 97 % by weight" and the second as "3 to 75% by weight" in the Abstract, which embraces that recited in claim 20 at 90 to 10, and 27 to 75. The number average molecular weight is given at column 6 (lines 18-23) and embraces that of claim 24 completely. The production of "films, fibers and moldings" is shown at column 1 (lines 32-34). The reference shows a very low solubles content at Table 2 of columns 9 and 10. Further, note column 6 (lines 24-31 and 62-67). Since the compositions are essentially identical to those claimed, the compositions would inherently possess the haze value range and tensile E modulus recited in claim 18. Nothing is recited that would indicate otherwise. Likewise, the composition would inherently possess the glass transition range recited in claim 22.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-20 and 24-27 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Mochizuki et al (US 6,511,755), newly cited.

The patent to Mochizuki et al teaches the production of a propylene copolymer blend that may comprise a first copolymer having from 1.5 to 10% by weight comonomer, which may be ethylene, with a second copolymer embracing the olefin content, which may be ethylene, at 20 to 30 % by weight, as recited in claims 17 and 19. Note column 4 (line 51) to column 5 (line 25). That passage also shows manipulation of haze due to the presence of propylene, as recited in claim 18. Further, note column 12 (lines 37-45) in that regard, and the data in Tables 1 and 2. The range of inclusion for the two copolymers is shown at Table 7 (claim 20) to embrace those claimed herein. The manipulation of the molecular weight is shown at column 9 (lines 14-16). The process of claim 25 is shown at column 9 (lines 29 et seq.). The production of films is shown throughout the patent (claims 26 and 27). Although the reference is silent as regards the extractables, a skilled artisan would know to manipulate these values for desired end-use characteristics. As such, a skilled artisan would have a high level of expectation of success following the teachings of the reference to achieve the claimed inventions.

Claims 17, 19-21 and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Delaite et al (US 6,586,528), newly cited.

The patent to Delaite et al teaches the manufacture of a propylene copolymer blend that may comprise a first copolymer, present in the amounts of 55 to 74 parts, having 1% by weight ethylene, with a second propylene copolymer, present in the amounts of 26 to 45 parts, having an ethylene content overlapping that claimed at 10 to

Art Unit: 1711

15% by weight, as recited in claims 17, 19 and 20. The reference teaches the inclusion of nucleating agents at column 3 (lines 53-59), as in claim 21. The reference teaches the production of articles and films, as in claims 26 and 27. Note column 1 (lines 16-21). The process, as recited in claim 25, is shown at column 5 (lines 10 et seq.). Further, note column 4 (lines 65-67) and column 5 (lines 43-49) which teaches manipulation of the molecular weight and the molecular weight distribution, as in claims 23 and 24. Further, note the Examples. Although the reference is silent as regards the extractables, a skilled artisan would know to manipulate these values for desired end-use characteristics. As such, a skilled artisan would have a high level of expectation of success following the teachings of the reference to achieve the claimed inventions.

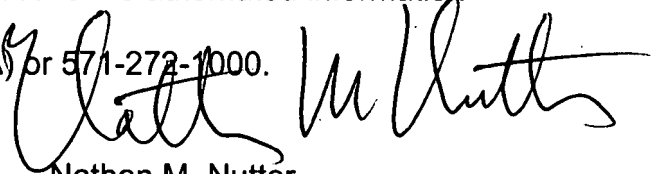
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 1711

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Nathan M. Nutter  
Primary Examiner  
Art Unit 1711

nmn

30 May 2007